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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,576	08/27/2002	Lewis Dewi	NIDN-73247	3162

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AMERSHAM HEALTH  
IP DEPARTMENT  
101 CARNEGIE CENTER  
PRINCETON, NJ 08540-6231

EXAMINER
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JONES, DAMERON L

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/009,576

Applicant(s)

DEWI ET AL.

Examiner

D. L. Jones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 8/11/04 & 9/2/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,4-10,13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4-10, 13, and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## **ACKNOWLEDGMENTS**

1. The Examiner acknowledges receipt of the amendment filed 9/2/04 wherein claims 1, 8, 13, and 14 are amended and claims 2, 3, 11, 12, and 15 are canceled.

**Note:** Claims 1, 4-10, 13, and 14 are pending.

2. The Examiner acknowledges receipt of the amendment filed 8/11/04 wherein the specification was amended and an abstract was submitted.

## **RESPONSE TO APPLICANT'S AMENDMENT/ARGUMENTS**

3. The Applicant's arguments filed 9/2/04 to the rejection of pending claims 1, 4-10, 13, and 14 made by the Examiner under 35 USC 103 and/or 112 have been fully considered and deemed non-persuasive for the reasons set forth below.

### **112 First Paragraph Rejection**

The rejections of claims 1, 4-10, 13, and 14 under 35 USC 112, first paragraph, because the specification, while being enabling for compositions comprising the iodide/iodine in combination with substrates polyvinyl alcohol, zeolite, natural carbon, solidified carbonaceous material, and silica, does not reasonably provide enablement for all possible substrates and iodine containing compounds is MAINTAINED for reasons of record in the office action mailed 2/9/04 and those set forth below.

Applicant asserts that the instant invention is limited to those substrates which are substantially non-radiation attenuating and the iodine containing compounds disclosed on page 6, lines 4-7.

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Applicant is reminded that the claims are not limited to the disclosure of the specification, but are interpreted broadly. For example, the specification discloses specific iodine containing compounds while the claims read 'iodine containing compounds'. Thus, the claims not only read on the specific iodine containing compounds of the specification, but all others disclosed in the prior art. Furthermore, it should be noted that independent claim 1 is a product. Hence, patentability of the claim is based on the components present in the product, not on the intended use or what various components in the product do (i.e., adsorb to a surface).

Applicant asserts that undue experimentation is not necessary to perform the instant invention.

The instant invention does result in undue experimentation because of the breadth of the claims for reasons of record in the office action mailed 2/9/04 and those stated above.

**112 Second Paragraph Rejection**

The rejection of claims 1, 4-10, 13, and 14 under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention is MAINTAINED for reasons of record in the office action mailed 2/9/04 and those set forth below.

Applicant asserts that the Examiner has mischaracterized the claims because they are directed to a brachytherapy source, not a multitude of iodine-containing compounds, non-radiation attenuating substrates, and brachytherapy sources.

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Independent claim 1 is directed to a product; thus, the intended use of that product (for use in brachytherapy) is not given patentable weight. Note that the patentability of a product is based upon the components of the product, not the intended use for the product. Claim 13, which depends on claim 1, reads on treatment of any possible condition, which is responsive to radiation therapy. Claim 14 which depend on claim 14 reads on inhibition of restenosis. Thus, the instant invention does encompass a multitude of iodine-containing compounds, non-radiation attenuating substrates, and brachytherapy sources.

**103 Rejections**

The rejection of claims 1, 4-10, 13, and 14 under 35 USC 103(a) as being unpatentable over Suthanthiran et al (US Patent No. 4,994,013) is MAINTAINED for reasons of record in the office action mailed 2/9/04 and those set forth below.

Applicant asserts that the cited prior art fails to disclose either a biocompatible echogenic container or an isotope adsorbed on a substrate.

Applicant is once again reminded that independent claim 1 is directed to a product and patentability is based upon the components of the product, not what each component does (i.e., bind to a surface). In addition, in column 5, lines 13-26, Suthanthiran et al disclose that the pellet may be encapsulated in a container made of material other than titanium, provided that the container does not substantially inhibit irradiation from the seed and provided that the container material is resistant to corrosion by body fluids. Also, in column 41-46, disclose an embodiment wherein the pellet is loaded with the desired radioactivity and encapsulated preferably by a titanium

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container. Hence, Suthanthiran et al disclose a biocompatible echogenic container wherein the substrate and radioactive are sealed within.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (571) 272-0617. The examiner can normally be reached on Mon.-Fri., 6:45 a.m. - 3:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on (571) 272-0887. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. L. Jones  
Primary Examiner  
Art Unit 1616

November 24, 2004